

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Patent Application No. 10/680,542

Confirmation No. 5000

Applicant: Mody et al.

Filed: October 7, 2003

TC/AU: 2178

Examiner: Samir Termanini

Docket No.: 224183 (Client Reference No. 03,201US)

Customer No.: 23460

**APPELLANTS' REPLY UNDER 37 C.F.R. SECTION 41.41**

Mail Stop Appeal Brief – Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This paper is filed in response to the Examiner's Answer mailed on May 30, 2008.  
Appellants hereby respectfully request allowance of the pending claims for the reasons set forth in Appellants' Appeal Brief filed on February 29, 2008, and for the further reasons stated herein.

*Real Party In Interest*

The patent application that is the subject of this appeal is assigned to Invensys Systems, Inc.

*Status of Claims*

Claims 1-18 stand finally rejected, and these rejections are presently being appealed.

A complete listing of these claims appears in the Claims Appendix.

*Grounds of Rejection to be reviewed on Appeal*

The grounds of rejection to be reviewed on appeal are the grounds stated in the Final Office Action mailed on June 28, 2007. In particular, Appellants appeal:

1. The rejection of claims 1-18 as obvious under 35 U.S.C. §103(a) over Viewsonic (Publication A-CD-ViewPad 1000-1, 2001) in view of Wonderware's FactorySuite program as described in the FactorySuite InTouch User's Guide, June 2001 (InTouch).

*Argument in Reply to Examiner's Answer*

Appellants have carefully reviewed the Answer. The first portion of the Answer, beginning at page 3 and ending at page 15, is identical to the grounds recited in the Office Action from which the present appeal was taken. Appellants have addressed the Answer's grounds for rejection in the previously filed Appellants' Appeal Brief, and thus Appellants will not repeat these arguments. Appellants' Reply will address the "Responses to Argument" that begin on page 15 of the Answer.

The Answer misapplies the claim construction guidelines set forth in *Phillips v. AWH Corp.*, 75 USPQ2d 1321 (Fed. Cir. 2005)(en banc). Appellants submit that *Phillips* sets forth the *sole* procedure for claim construction. Disregarding any of the relevant sources of information for construing claim elements set forth in *Phillips*, whether during litigation or prosecution, is improper. The rejection of the presently pending claims is premised upon an unreasonably broad claim construction that improperly applies the claim construction procedure specified by *Phillips*.

In particular, the rejection of the presently pending claims is premised upon a misinterpretation of the clause "wherein the application programs interact with a user via a set of tablet PC interface services" recited in claim 1. The Answer interprets the "tablet PC interface services" as a broad set of functional software entities (including application programs). The Answer construes the "set of tablet PC interface services" to include all of the "Common Services 220" depicted in FIG. 2 and described in the first full paragraph of page 8 of Appellants' specification. Appellants respectfully submit the claimed "set of tablet PC interface services" includes a portion of the Common Services 220 that are directed to the human-machine

interface of a tablet computer (as opposed to the I/O interface for printing and network communications that are also supported by the Common Services 220). Moreover, the Answer misconstrues the “tablet PC interface services” as including standalone applications (e.g., PenOffice referenced at page 17 of the Answer). Appellants’ claimed “tablet PC interface services” are incorporated into the application programs. See, Appellants’ specification, page 8, lines 8-10.

Furthermore, even if the improperly broad interpretation of the aforementioned “tablet PC interface services” is maintained, the continued rejection of separately argued claims directed to the “annotation” tablet PC interface service (**claims 5, 10 and 16**) is improper since the claimed “annotation” service functionality is not disclosed in the teachings of the cited prior art references.

The discussion below addresses the Answer's unduly broad scope attributed to the “set of tablet PC interface services” element in the "Response to Arguments" section beginning at page 15 of the Answer.

*The Answer's Response to Argument Regarding Claims 1-4, 6-9, 13-15, 17 and 18 Improperly Equates “Common Services” and Appellants’ Claimed “Tablet PC Interface Services” and Asserts the “Services” Can Be Standalone Applications*

Notwithstanding the continued rejection of independent claim 1, there is agreement that claims are to be interpreted “in light of the specification as it would be interpreted by one of ordinary skill in the art.” See, Answer, page 15, bottom paragraph. The Answer’s Response to Argument thereafter *misinterprets* the relationship between the “common services” described in the specification and the more restrictive term “tablet PC interface services” recited in claim 1. The “set of tablet PC interface services” element is narrower than “common services” but broader than the particular “annotation” service example. The “set of tablet PC interface services” element encompasses interface services supporting the *HMI of a tablet PC* facilitating interactions between users and application programs running on the tablet PC.

Appellants describe a set of “common services” in the written description of FIG. 2 contained in the first full paragraph on page 8. The “common services” include: (1) services associated with an HMI of a tablet PC (e.g., “annotation service”), AND (2) I/O services (e.g.,

print, email, etc.). Appellants chose a more restrictive term – “tablet PC interface services” – to claim/recite a set of services that exploit tablet-PC extensions (e.g., electronic pen) associated with the HMI of a tablet PC. If Appellants had intended to include all types of services incorporated into a tablet PC, Appellants would have used the term “common services” comprising both tablet PC interface services and I/O services (e.g., printing) associated with I/O (e.g., printer, network communication) interfaces on the PC. See, Appellants’ specification at page 8, lines 14-18. Appellants’ specification describes the common services as being incorporated into the application programs. See, Appellants’ specification, page 8, lines 8-10.

The reasonable scope of the term “tablet PC interface services” is also established by the context of its usage in claim 1 to define a tablet personal computer system for use in an industrial process management environment. First, Appellants claim 1 recites a “human-machine interface” including a touch-sensitive display region. Thereafter, Appellants recite a set of application programs that “interact with a user via a set of tablet PC interface services associated with the human-machine interface.” The claimed tablet PC interface services are recited within the “application programs” element of claim 1.

The Answer, at page 17, asserts that PenOffice, an application that runs alongside applications running on the ViewSonic device, corresponds to the claimed “tablet PC interface services.” However, the claimed “tablet PC interface services,” are incorporated into the application programs themselves. The “tablet PC interface services” are recited in claim 1 within the “set of one or more application programs” element. The PenOffice application referenced in the last full paragraph of page 17 of the Answer is an application program that operates alongside another application program having a window displayed on the ViewSonic touchscreen graphical user interface. The PenOffice application is not a “service” as that term is defined by Appellants’ specification. The prior art does not disclose the properly construed “set of tablet PC interface services” element recited in claim 1, and the rejection of claim 1 should therefore be reversed.

Appellants reiterate that the prior art InTouch® HMI application did not incorporate Appellants’ disclosed “set of tablet PC interface services associated with the human-machine interface (including a touch-sensitive display region) integrated into a tablet personal computer. The Answer does not identify any *services* in the prior art references that could be incorporated into the InTouch® HMI application to enable such functionality. The absence of a teaching in

the cited prior art of the claimed "tablet PC interface services" element precludes a *prima facie* showing of obviousness.

*There Is No Motivation for Combining the InTouch® HMI and the ViewSonic Device*

Finally, Appellants reiterate that there was no motivation to load and execute the InTouch® HMI application on the ViewSonic device. Though one could possibly load the prior art InTouch® application onto a Windows CE based system, the prior art InTouch® HMI application did not include the claimed "services" that would enable the InTouch® user to exploit the tablet PC user interface's electronic pen/stylus such as, for example, by annotating a view of an InTouch® application. See, FIGs. 4 and 5 of Appellants' application.

The desirability of the present invention arises from the new features supported by the tablet PC-enabled applications that are provided, by way of example, with reference to FIGs. 4 and 5 of the present application. The prior art InTouch® application did not include the features described by Appellants with reference to FIGs. 4 and 5, and thus the functionality of the prior art InTouch® application is not enhanced by modifying its code to support exploitation of tablet PC interface services such as those provided by the ViewSonic tablet PC and the PenOffice application program described on page 31 of the ViewSonic reference. One skilled in the art at the time of the invention would not be motivated to modify InTouch® in a way that would render the claimed invention. *It is the disclosed "services" (e.g., Annotation in FIG. 2) that provides the desirability to combine InTouch and the tablet PC. However, it is these claimed "services" that are absent from the teachings of the prior art.* Thus, Appellants respectfully submit that the combined teachings of ViewSonic's tablet PC and Appellant's own prior InTouch® application program would not render the claimed invention obvious.

*The Answer Does Not Address the Absence of Any Teaching in the Prior Art Regarding the Claimed Annotation Element of Claims 5, 10 and 16*

In particular claimed embodiments, corresponding to **claims 5, 10, and 16**, one of the supported tablet PC services is an "annotation" service that facilitates capturing and annotating a view presented on the display of a tablet PC running an industrial process supervisory control application.

Claims 5, 10 and 16 each recite claim elements corresponding to the disclosed Annotation service of the set of Common Services. The teachings of ViewSonic and InTouch do not include the claimed Annotation functionality for capturing and annotating a view on a tablet PC's graphical interface. The prior art InTouch® HMI application was not designed to exploit tablet PC's in general and electronic pens specifically. Appellants again refer to their examples described with reference to FIGs. 4 and 5 and respectfully submit that these capabilities did not exist in the prior art version of InTouch®, and thus the inventions recited in each of the dependent claims 5, 10 and 16 are neither disclosed nor suggested by the combined teachings of the ViewSonic tablet PC and the prior art InTouch® application.

In summary, Appellants' recited invention is not obvious over the prior art. The recited invention goes beyond merely combining a prior art version of InTouch® with the ViewSonic tablet PC. Claim 1 recites a set of application programs relating to supervisory control of industrial processes which *interact with a user via a set of tablet PC interface services*. This recited element of Appellants' presently claimed invention is not taught or suggested in the combined teachings of the ViewSonic tablet PC and the InTouch® HMI application.

### *Conclusion*

The present invention is not rendered obvious from the combined teachings of ViewSonic's ViewPad 1000 Tablet PC and Wonderware's FactorySuite InTouch User's Guide. For the reasons stated herein above, the presently pending claims are patentable over the prior art presently known to Appellants. Appellants therefore request reversal of the presently pending rejection of claims 1-18.

Respectfully submitted,



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*Claims Appendix*

1. (Original) A tablet personal computer system and software facilitating performing a variety of design, supervisory and/or data management tasks associated with industrial processes including:

a human-machine interface, including a touch-sensitive display region, integrated into a tablet personal computer;

a wireless communication resource; and

a set of one or more application programs relating to supervisory control of industrial processes, wherein the application programs interact with a user via a set of tablet PC interface services associated with the human-machine interface.

2. (Original) The tablet personal computer system of claim 1 wherein the human-machine interface includes an electronic pen user interface.

3. (Original) The tablet personal computer of claim 2 further comprising handwriting recognition software.

4. (Original) The tablet personal computer system of claim 2 further comprising a handwriting input recognition panel.

5. (Original) The tablet personal computer system of claim 2 further comprising an annotation functionality enabling capture and annotation, using the electronic pen user interface, of a view displayed on the tablet personal computer.

6. (Original) The tablet personal computer system of claim 1 wherein an application program supports collaborative design functionality that enables users to review, edit and annotate a proposed design for industrial process control.

7. (Original) The tablet personal computer system of claim 1 wherein the set of applications includes a production management application program supporting access to a set of databases.

8. (Original) The tablet personal computer system of claim 1 wherein the set of application programs includes application verification software for confirming proper design logic by setting values and observing statuses of controlled equipment.

9. (Original) The tablet personal computer system of claim 1 wherein the set of application programs includes application software enabling data entry for controlling a plant floor device.

10. (Original) The tablet personal computer system of claim 1 further comprising an integrated camera, and wherein the set of application programs includes application software supporting capturing an image and further annotating the captured image.

11. (Original) The tablet personal computer system of claim 10 wherein the camera is a still image camera.

12. (Original) The tablet personal computer system of claim 10 wherein the camera is a video camera.

13. (Original) The tablet personal computer system of claim 1 wherein the set of application programs includes application software for receiving data input for entry into a database.

14. (Original) The tablet personal computer system of claim 1 wherein the set of application programs includes application software facilitating offline data analysis.

15. (Original) The tablet personal computer system of claim 1 wherein the set of application programs includes application software facilitating online data analysis.

16. (Previously presented) The tablet personal computer system of claim 1 wherein the set of application programs includes application software incorporating a user interface for selectively capturing and annotating, via handwritten input, real time information.

17. (Original) The tablet personal computer system of claim 1 wherein the set of application programs includes application software for capturing end of shift snapshots.

18. (Original) The tablet personal computer system of claim 1 further including user authentication mechanisms.